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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,728	06/18/2001	Yoichiro Tomari	1163-0341P	8265

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EXAMINER

ALAUBAIDI, HAYTHIM J

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/881,728

Applicant(s)

TOMARI ET AL.

Examiner

Haythim J. Alaubaidi

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is a Final Office Action in regard to the amendment filed on March 09, 2004.
2. Claims 1-19 are presented for examination following the amendment, of which Claims 1, 9, 13 and 17 are Independent.
3. The Examiner acknowledges the new added claims 18-19.

Priority

4. Applicant's claim for foreign priority under 35 U.S.C. §119(a)–(d) is acknowledged, the Applicant was accorded the benefit of the earlier filing date of November 10, 1999.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-19, are rejected under 35 U.S.C. 102(e) as being anticipated by Bryan I-chuen Lee (U.S. Patent No. 6,212,553 and Lee hereinafter).

Regarding Claim 1, Lee discloses an information history list display section for displaying communication history¹ (Figure 14, 35 and 36 and corresponding text) in connection with answering state of the respective communication (Figure 36, Elements 3620 and 3610 and corresponding text; see also Figure 14, i.e. status; see also Col 5, Lines 49-56) based on history related information² (Figures 35 and 36 and corresponding text)³ which is generated by outgoing or incoming communication (Figures 35 [outgoing] and 36 [incoming] and corresponding text) and indicates the answering state of the respective communication (Figure 36, Elements 3620 and 3610 and corresponding text; see also Figure 14, i.e. status; see also Col 5, Lines 49-56).

Regarding Claim 2, Lee discloses
a history management section for recording the communication history (Col 8, Lines 60-64);
and an information management table for recording the history related information (status) that indicates the answering state of the respective communication stored in said history management section (Col 5, Lines 57-64; see also Col 23, Lines 16-37).

¹ Please note that the Examiner is interpreting the "communication history" to be the same as an "e-mail message". This is according to the Specification of the current application (see page 1, Lines 15-17).

² Please note that the Examiner is interpreting the "history related information" to be the same as a "status" of n e-mail.

³ The "history related information" would be the e-mails that were sent out the first time to inquire about the Christmas Party.

Regarding Claim 3, Lee discloses wherein said information management table records relationships between the respective communication (e-mail) and said information history list display section (Col 5, Lines 57-64; see also Figure 14 and associated text).

Regarding Claim 4, Lee discloses plurality of different communication means (Figure 1, Element 12 and 13; see also Col 13, Line 49).

Regarding Claim 5, a personal address book for recording a personal name of a communication party (Figure 3, Element 335; see also Col 13, Line 52) and a communication address of the communication party (Col 13, Line 52); and an address book search section for searching said personal address book (Col 17, Lines 24-39) wherein said information history list display section displays the personal name in substitution for the communication address included in the history information stored in said history management section in accordance with a retrieval result from said personal address book by said address book search section (Figure 14 and corresponding text, i.e. the names of the names of the senders under the "From" column displays the personal name, such as, "Bob Winters" in substitution for the communication address (e-mail address).

Regarding Claim 6, Lee discloses wherein the communication history (e-mails) and the history related information (status) are stored in a server (Col 9, Lines 8-10).

Regarding Claims 7 and 8, the limitations of these claims are similar in scope to the rejected claims 2 and 6, above. They are therefore rejected as set forth above.

Regarding Claim 9, the limitations of this claim are similar in scope to the rejected claim 1, above. In addition, Lee discloses a server comprising: a personal information management section (address book with personal info) for transmitting, in response to a request, information to said information terminal (Col 17, Lines 24-38).

Regarding Claims 10-12, the limitations of these claims have been noted in the rejection of claim 9, above. In addition, Lee discloses:

- a history management section for recording communication history (Col 8, Lines 60-64); and

- an information management table for recording history related information which indicates the answering state of the respective communication stored in said history management section (Col 5, Lines 57-64; see also Col 23, Lines 16-37).

Regarding Claims 13-16, the limitations of this claim has been noted in the rejection of claims 1, 2 and 3, above.

Regarding Claim 17, Lee discloses:

- recording communication of respective communication (Col 8, Lines 60-64)

- recording history related information and indicates an answering state of the respective communication (Col 5, Lines 57-64; see also Col 23, Lines 16-37)

- and displaying the respective communication in connection with the answering state of the respective communication based on the history related information (Figure 14, i.e. status; see also Col 5, Lines 49-56).

Regarding Claims 18-19, the limitations of these claims are similar in scope to the rejected claims 1-3, above. They are therefore rejected as set forth above.

Response to Arguments

7. Applicant's arguments filed in the amendment of March 09, 2004 have been fully considered but they are not persuasive.

Applicant argues that Lee does not teach information history list display section for displaying communication history in connection with answering state of the respective communication based on history related information which is generated by outgoing or incoming communication and indicates the answering state of the respective communication. The Examiner however disagree. Lee's reference does teach the limitations of information history list display section for displaying communication history in connection with answering state of the respective communication based on history related information which is generated by outgoing or incoming communication and indicates the answering state of the respective communication (please refer to the rejection of Claim 1 above and the newly cited areas of Lee's reference).

Other Prior Art Made of Record

8. a. Murakami et al. (U.S. Patent No. 5590178) discloses an electronic mail system linked with telephone; and

b. Grossman et al. (U.S. Patent No. 5436965) discloses a method and system for optimization of telephone contact campaigns.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Points of Contact

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haythim J. Alaubaidi whose telephone number is (703) 305-1950. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

Any response to this office action should be mailed to:

The Commissioner of Patents and Trademarks, Washington, D.C. 20231 or telefax at our fax number (703) 872-9306.

Hand-delivered response should be brought to Crystal Park II, 2121 Crystal Drive, 6th Floor Receptionist, Arlington, Virginia. 22202.

Haythim J. Alaubaidi

Patent Examiner
Technology Center 2100
May 24, 2004



SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100